

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Huitao Luo et al. Art Unit : 2624
Serial No. : 10/653,019 Examiner : Ge, Yuzhen
Filed : Aug. 29, 2003 Confirmation No.: 2100
Title : DETECTING AND CORRECTING REDEYE IN AN IMAGE

Commissioner for Patents
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RESPONSE TO ELECTION REQUIREMENT

In the Office action dated January 22, 2007, the Examiner has indicated that an election is required between the proposed “species” of Groups I, II, III, and IV. In response to this election requirement, applicant provisionally elects the “species” of FIGS. 14-18B (i.e., Group III) with traverse. Claims 28-51 read on the elected “species” of Group III.

As explained in detail below, however, the election requirement is submitted to be improper because (1) the Examiner is not authorized to require the proposed election of “species”, (2) the Examiner has not established a *prima facie* case for requiring the election of “species”, and (3) no valid reason exists for dividing among these “species”.

I. The Examiner is not Authorized to Require the Proposed Election Requirement

The election requirement is traversed because the Examiner is not authorized to require the proposed election of “species”. In particular, 37 CFR 1.146, which authorizes the Examiner to require an election of species, applies only to “an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby.” The instant application, however, currently does not contain a generic claim that embraces all the embodiments shown in FIGS. 6A-11B, 12, 14-18B, and 29. Without such a generic claim, the embodiments of FIGS. 6A-11B, FIG. 12, FIGS. 14-18B, and FIG. 29 do not constitute species to which the claims properly can be restricted under 37 CFR 1.146 (see MPEP § 806.04).

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For at least this reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

II. The Examiner has not Established a *Prima Facie* Case for the Election Requirement

MPEP § 808.01 explains that:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

In the instant case, the Examiner merely has stated that “The species are distinct because they have different modes of operations and different designs.” The Examiner has not given any reasons upon which his conclusion is based. Therefore, the Examiner has not made the showing required under MPEP § 808.01 and, consequently, the Examiner has not established a *prima facie* case for the election requirement.

For at least this additional reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

In addition, the proposed “species” of Groups I-IV are related. For example, FIG. 1 shows and embodiment of a system 10 for detecting and correcting redeye pixels in a digital input image 12 that includes a redeye detection module 14 and a redeye correction module 16 (see page 5, line 30 - page 6, line 3, of the specification). The features of the disclosed embodiments corresponding to the asserted “species” of Groups I-III are incorporated within the redeye detection module 14 (see, e.g., § II beginning on page 7 of the specification) and the features of the disclosed embodiments corresponding to the asserted species of Group IV are incorporated within the redeye correction module 16 (see, e.g., § III beginning on page 27 of the specification). FIG. 12 shows that the “species” of Group I is usable in the “species” of Group II. FIG. 4 shows that the “species” of Groups I and II are usable together with the “species” of Group III in embodiments of the redeye detection module 14. FIG. 1 shows that the “species” of Groups I-III are usable together with the “species” of Group IV in embodiments of the system 10.

In the case of related inventions, MPEP § 806.05(j) explains that:

To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for

insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02. See MPEP § 806.05(c) for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a combination/subcombination relationship. For other related product inventions, or related process inventions, the inventions are distinct if

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented.

As explained above, the only explanation given by the Examiner in support of the election requirement is that “The species are distinct because they have different modes of operations and different designs.” Therefore, the Examiner has not made the showing required under MPEP § 806.05(j). For this reason, the Examiner has not established a *prima facie* basis for requiring election between each of the proposed “species” of Groups I-IV

For at least this additional reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

III. No Valid Reason Exists for Dividing Among the Related Inventions

In general, if “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions” (MPEP § 808.02).

The Examiner has not indicated that the classifications of the proposed “species” of Groups I-IV are different. Therefore, Examiner has not provided any reasonable basis for believing that the classifications of proposed “species” of Groups I-IV are not the same. In addition, the Examiner has not pointed to any clear indication that the classifications of the proposed “species” of Groups I-IV would be different in the future. Thus, the Examiner has not shown that separate examinations are required for the proposed “species” of Groups I-IV.

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Accordingly, "no reasons exist for dividing among related inventions" and the election requirement should be withdrawn in accordance with MPEP § 808.02.

III. Conclusion

For the reasons explained above, Applicant requests that the election requirement be withdrawn upon reconsideration.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: February 21, 2007



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